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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,883	05/24/2006	Peter Dahmen	2400.0180000/RWE/L-Z	8057
26111 7590 04/07/2010 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER HOLLOMAN, NANNETTE				
ART UNIT		PAPER NUMBER		
1612				
MAIL DATE		DELIVERY MODE		
04/07/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,883

Applicant(s)

DAHMEN ET AL.

Examiner

NANNETTE HOLLOMAN

Art Unit

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-5 and 8-10 is/are pending in the application.
- 4a) Of the above claim(s) 3-5 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 9-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office Action is in response to the Request for Continued Examination filed on January 29, 2010. Applicants' arguments, filed November 18, 2009, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Information Disclosure Statement

The IDS filed November 18, 2010 was considered on December 14, 2009. A copy of the considered IDS was mailed January 6, 2010 with the previously mailed Advisory Action.

Claim Rejections - 35 USC § 112

Claims 1, 9 and 10 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement and second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the inventions. These rejections are maintained.

First Paragraph

Applicant's Arguments: Applicant argues even though the specification or the claims as originally filed did not use the phrase "consisting essentially of" literally in describing the claimed invention, one of ordinary skill in the art would reasonably conclude that Applicants were in possession of the invention as now claimed at the time of filing at least because Applicants described an exemplary composition containing three active compounds. Applicant's arguments have been fully considered but they are not persuasive.

Examiner's Response: Applicant has not shown what it regarded as constituting a material change in the basic and novel characteristics of the claimed composition. Since there appears to be no disclosure of "consisting essentially of" or any disclosure of what material would change the basic and novel characteristics of the claimed composition the phrase "consisting essentially of" is "new matter". Applicant does not provide guidance as to how to determine what components would be excluded. An example only shows a preferred embodiment and does not provide guidance. In regard to Applicant's example, some extenders and/or surfactants materially affect the performance of active compounds; therefore it can not be determined by the claims or the example which extenders and/or surfactants do and do not affect the composition.

Second Paragraph

Applicant's Arguments: Applicant argues one of ordinary skill in the art would know whether a given ingredient in a fungicidal composition is an active compound or a formulation aid. Applicant's arguments have been fully considered but they are not persuasive.

Examiner's Response: The limitation of optionally including extenders and/or surfactants renders the claims indefinite, since it is not clear what materials change the basic and novel characteristics of the composition.

Claim Rejections - 35 USC § 103

Claims 1 and 9-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Dutzmann et al. (US Patent No. 6,306,850). This rejection is maintained.

Applicant's Arguments: Applicant argues Dutzmann does not disclose the specific three-compound composition containing fluoxastrobin, prothioconazole and tebuconazole and is silent to the ratio of fluoxastrobin to tebuconazole. Applicant further argues synergistic effects, comparing different fungus and different test conditions. Applicant's arguments have been fully considered but they are not persuasive.

Examiner's Response: In regard to the three-compound composition and the ratio of fluoxastrobin to tebuconazole, as previously asserted, the reference discloses the combination of prothioconazole with at least one other active compound, therefore a combination of more than one active compound would be obvious. The reference discloses the ratio of prothioconazole to fluoxastrobin and prothioconazole to tebuconazole; which would lead one of ordinary skill to the ratio of fluoxastrobin to tebuconazole of 0.1:0.1 to 50:20.

Examiner notes the typographical errors in the Dutzmann patent; however applicant's claim to unexpected results does not appear to be supported. As Applicant disclosed, Table 7 of Dutzmann did not give 100% efficacy for prothioconazole alone; however, when looking to the International Publication, WO 98/47367 (as disclosed by applicant) at p. 51, Table 7, the ratio of prothioconazole to fluoxastrobin is 1:3 and the efficacy of the combination is 100%. Adding a third composition could not give anymore than the 100% received. As previously asserted, comparing the results in the Table on page 9 of the instant specification to the results in Table 5, column 37 of Dutzmann, the results for Dutzmann of the combination of prothioconazole and tebuconazole at a ratio of 1:1 and 1:3 resulted in an efficacy of 100%, furthermore adding a third composition could not give anymore than the 100% received, therefore there appears to be no support for synergism or unexpected results.

In regard to different fungus and different test results, there appears to be no comparison of different fungus species and Applicant has not shown that the slight difference in test conditions, i.e. 1 day, would have any impact on the results.

As previously asserted, assuming, purely *arguendo*, that unexpected results had been shown, Applicant's claims encompass a broader range than that shown in the Table on p. 9 of the instant specification and Tables 1 and 2 of the declaration filed June 3, 2009, therefore the examples are not commensurate in scope with the instant claims.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANNETTE HOLLOMAN whose telephone number is (571) 270-5231. The examiner can normally be reached on Mon-Fri 800am-500pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H./
Examiner, Art Unit 1612

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612